



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,367	02/11/2005	Fred A. Antonini	0771MH-42176-US	9853

38441 7590 03/03/2010
LAW OFFICES OF JAMES E. WALTON, PLLC
1169 N. BURLESON BLVD.
SUITE 107-328
BURLESON, TX 76028

EXAMINER

LONEY, DONALD J

ART UNIT	PAPER NUMBER
----------	--------------

1794

MAIL DATE	DELIVERY MODE
-----------	---------------

03/03/2010

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/524,367

Applicant(s)

ANTONINI, FRED A.

Examiner

Donald Loney

Art Unit

1794

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5, 9, 10 and 12-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5, 9, 10 and 12-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-06)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-5, 9, 10 and 12-25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claim 1, 2 and 4-6 of copending Application No. 11/072382. Although the conflicting claims are not identical, they are not patentably distinct from each other because any layer can be considered decorative to some degree since the applicant does not recite any particular structure thereto.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

3. Claims 1-5, 9, 10 and 12- 25 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 4-25 of copending Application No. 10/523942. Although the conflicting claims are not identical, they are not patentably distinct from each other because any layer can be considered decorative to some degree since the applicant does not recite any particular structure thereto.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 9, 10, 12, 13, 15, 20 and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Marks (6117526).

Marks discloses a slip resistant appliqué skin for use with a hand held electronic device comprising a decorative substrate layer 120, an anti-slip layer 110 there over and an adhesive layer 130 on the substrate which would be disposed between the device and substrate per claim 1. With regards to the amended "non-abrasive" limitation in claims 1 and 20, the third and fourth embodiments in column 5 do not disclose

abrasive particles. Additionally, this recitation is merely a relative term, wherein everything is abrasive to a certain degree even if it is smooth. Refer to the Abstract, figure 1 and column 4, line 54 through column 5, line 59. With regards to claims 9, 10, 12 and 13, the textured surface of layer 110 is non-smooth and contains a combination of depressed and/or raised portions as shown in figure 1. With regards to claim 15, see column 2, lines 63-65. With regards to claims 20 and 21, two separate portions are shown in figure 3.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 2-5, 14, 16-19 and 22-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marks in view of WO 00/08622 to Neal.

The primary reference teaches the invention substantially as recited except for the thicknesses of the layers and a printed decorative layer. It is silent as thereto. See the 35 U.S.C. 102 rejection above.

Neal discloses that an anti-slip label can be formed with the anti-slip-layer 4 and decorative layer (any of 4-7) can be of a thickness of less than 0.5mm per claims 2 and 22. See figures 1-3, page 8, lines 7-9 and page 10, lines 6-10.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to Marks to form the anti-slip layer and decorative layer of a thickness of less than 0.5mm, as is taught to be known by Neal, since these are known thicknesses for these layers. With regards to claim 3, all layers above print layer 6 can be transparent in order to be able to view the print layer in Neal (see page 9, lines 18-20). With regards to claim 4, a print layer 6, or printing on layer(s) 3 are disclosed (see layer 6 and page 9, lines 1-14). With regards to claim 5, the outer surface of elastomeric anti-slip layer 4 appears smooth (see figures 1-3). With regards to claim 14, the product is label stock (see Abstract and page 8, lines 26-28). With regards to claims 18, 19, 24 and 25, see page 3, line 21 through page 7, line 36 for the thermoplastic rubber used for the anti-slip layer. With regards to claims 17 and 23, to substitute silicone resin for the elastomer as taught by Neal would be obvious to one of ordinary skill in the art since this would merely involve substituting one anti-slip material for another one.

Response to Arguments

9. Applicant's arguments filed December 7, 2009 have been fully considered but they are not persuasive. The applicant argues that the examiner has not addressed many facets of the invention as recited in claims 1 and 20 in the rejection over Marks, wherein there is an anti-slip layer of high coefficient of friction material and that the skin is shaped to conform to the contours of a handheld electronic device, however, Marks discloses a slip resistant (i.e. anti-slip) high friction appliqué made of a flexible resilient material (column 2, line 63 through column, line 20) which can conform to curved surfaces when applied thereto. The compressible limitation per claim 15 is met due to the disclosure of a resilient material as indicted above. With regards to the adapted to be separated limitation per claim 21, the sections are separated into two portions which meets the recited limitation since the applicant does not specifically recite how the portions are "adapted to be separated". The applicant also argues that Marks has nothing to do with a thin soft anti-slip appliqué of high coefficient of friction, however, from the Title and the section referred to above, it is a soft high friction anti-slip appliqué. The applicant argues that Marks does not disclose a "non-abrasive surface" since the tape includes abrasive particles, however, only the first and second embodiment in column 5 include abrasive particles wherein the third and fourth embodiment do not disclose particles. Additionally, this recitation is merely a relative term, wherein everything is abrasive to a certain degree even if it is smooth. With regards to the applicant's arguments with respect to the rejection over Marks in view of Neal, arguing that Neal has nothing to do with appliqués, one cannot show

nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald Loney whose telephone number is (571) 272-1493. The examiner can normally be reached on Mon, Tues, Thurs and Fri. 8AM-4PM, flex schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on 571 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Donald J. Loney/
Primary Examiner
Art Unit 1794

DJL;D.Loney
02/27/10